

**REMARKS**

This Substitute Amendment was prepared in response to a second Office action (Paper No. 11) dated the 13<sup>th</sup> of March 2003, and being submitted to the U.S. Patent & Trademark Office in response to the Notice of Non-Responsive Amendment mailed on 17 November 2003 (Paper No. 15). It is respectfully requested that the Examiner substitute this Substitute Amendment for Applicant's previously filed Substitute Amendment dated 28 August 2003.

Claims 38 through 81 are pending. Claims 1 through 37 have been canceled in compliance with the U.S. PTO's third amendment of 37 C.F.R. §1.121(A).

**Rejection Of Claim 21 Under Second Paragraph Of 35 U.S.C. §112**

The Examiner has noted the withdrawal of the rejection of claim 21 under the second paragraph of 35 U.S.C. § 112.

**Rejection Of Claims 1, 2 & 10 Under 35 U.S.C. §102(b)**

Claims 1, 2 and 10 were again rejected under 35 U.S.C. §102(b) as anticipated by Ferros *et al.*, U.S. Patent No. 5,930,810. Applicant respectfully traverses this rejection for the following reasons.

In support of this rejection of claim 1, the Examiner wrote that Ferros '810 taught an Internet printing apparatus, comprising:

“a home page that can be accessed by a customer over the World

Wide Web, said home page comprising instructions of how a customer can request a print job, said home page further comprising a form that may be accessed through a hyperlink, said form enabling a customer to request said print job (col. 2, lines 24-27 and 51-55; col. 4, lines 27-30; col. 7, lines 46-51 and 53-65; and col. 8, lines 15-17);

a first memory storing a customer's printing parameters and a first draft of said customer's print job (col. 5, lines 14-20);

an editor connected to said first memory to edit said first draft of said customer's print job creating a finalized version of said customer's print job, said editor being distinguishable from said customer<sup>1</sup> (col. 8, lines 30-36 and 42-67; Fig. 4);

a second memory connected to said editor storing said finalized version of said customer's print job (col. 11, lines 45-52); and

an output device connected to said second memory via network printing to download said finalized version onto a recording media at a location of said customer's choice (col. 2, lines 27-32)."

**First**, the Examiner's understanding of Farros '810 is flawed. Farros '810 pertains to a print service that enables a customer, to:

- "chose to create a new order or to read in (and then modify) an existing order." Col. 9, lines 22, 23.
- choose from among "any number of categories of product" ... "(such as business cards or personal calling cards)." Col. 9, lines 24-26.
- choose within the specific category, "a number of different layouts [that] are usually available." Col. 9, lines 26, 27.
- make "at step 1016, a final visual verification of the print order [that]

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<sup>1</sup> The Examiner asserted in footnote 2, that Fig. 4 discloses the remotely-located storage and printing facility. This teaching relies on the broad definition of "edit" discussed under claim 11 in the Response to Arguments. Because "editing" is essentially preparing a document for publication, Farros' remotely-located printing facility, which prints the users' documents, discloses the claimed editor.

is displayed.” Col. 10, lines 62-64.

As explained in Applicant’s earlier filed response, the customer creates the document, submits the job order for printing and arranges for payment either from a personal computer or a kiosk. The Examiner however, makes a disingenuous argument that “because *editing* is essentially preparing a document for publication, Farros’ remotely-located printing facility, which prints the users’ documents fails to disclose either Applicant’s editor or the division of labor intrinsic is having some entity other than the user perform “editing.”

In view of 35 U.S.C. §102, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. Inc. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Absence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible Inc.*, 230 USPQ81, 84 (Fed. Cir. 1986).

The U.S. Patent and Trademark Office has the burden of proof, by a preponderance of evidence, to show that an applicant is not entitled to a patent because the claimed subject matter is anticipated by, or is obvious from, the art of record. A patent applicant is entitled to a patent “**unless**” the U.S. Patent and Trademark Office establishes otherwise. See, e.g., *In re Dembiczak*, 175 F.3d 994, 1001, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999); *In re Epstein*, 32 F.3d 1559, 1564 (Fed. Cir. 1994); *In re Rijckeart*, 9 F.3d 1551, 1552, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

The Examiner has confused two different process steps, found, and separately discussed by both Farros ‘810 (as well as in other exemplars of the novelty printing industry

such as Goldberg '146 (which is of record here)) and Applicant's claim 1, namely "editing" and manufacturing."<sup>2</sup>

The Examiner ignores the fact that the rejected claims 1, 2 and 10 as well as now pending claims 45, 46 and 54, separately define the publication and preparation of a document for publication, in lines 13 or 14. The Examiner should take care in reconsideration, to avoid confusing Applicant's *output device* which downloads the finalized version for production and manufacture of the finalized version of the customer's print job, as defined in lines 13 and 14, with Applicant's *editor*. A thorough reading of Farros '810 discloses that Farros '810 teaches the user, and the user alone, through the use of templates and menus, is solely responsible for the (1) "entry of textural information (personal information)" and verification in step 1002,<sup>3</sup> of the (2) selection of "the quantities of each orderable product" in step 1004,<sup>4</sup> and the selection of the (3) product type,<sup>5</sup> (4) category of product,<sup>6</sup> (5) layout of the chosen category,<sup>7</sup> and designation of the attributes of the category

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<sup>2</sup> The process of "editing" does not always result in "manufacturing" (i.e., publication) of the edited product.

<sup>3</sup> Farros '810, column 10, lines 51, 52.

<sup>4</sup> Farros '810, column 10, lines 54, 55.

<sup>5</sup> Farros '810, column 10, line 55.

<sup>6</sup> Farros '810, column 9, lines 23, 24.

<sup>7</sup> Farros '810, column 9, line 25.

<sup>8</sup> Farros '810, column 9, line 26.

in the plurality of options<sup>8</sup> presented to the user in step 1006,<sup>9</sup> to completion and submission of the order by the user in step 1012.<sup>10</sup> Neither taught nor suggested by Farros '810 is any division of labor made by Applicant's claim 45, these tasks are preformed solely and entirely by the user in response to a plurality of templates and menus. As may be seen from the foregoing annotated citations excerpted from Farros '810, no editing of any nature is performed by the printing system taught by Farros '810; each of the excerpts noted relies upon the user to make a selection from a plurality of templates and menus. As is explained by Farros '810,

“advantageously provide for the simple and fast generation of different types of printable media by those who do not have training in the area of graphical design. Laypersons, using the *pre-defined form*, may create aesthetically pleasing high quality products and electronically place a print order with a remote printing facility.” Col. 3, lines 5-10.

In short, Farros '810 has failed to anticipate each and all of the features of Applicant's rejected claims 45, 46 and 54. Withdrawal of this rejection is therefore mandatory.

**Second**, the Examiner asserts that “Farros clearly teaches storing editing programming on a Website server” (Paper No. 11, Examiner's Comments, pg. 3). Nowhere does the Examiner identify where this editing programming is clearly taught by Farros '810. In fact, the Examiner's interpretation of Farros '810 raises concerns, because Farros '810

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9 Farros '810, steps 1007-1011, column 10, line 56.

10 Farros '810, column 10, lines 60-67.

uses neither the verb “editing”, “edit” or “edited”. The fact that Figs. 5 and 7 contemplate changes of text and other attributes of a printing order by the user, does not provide anticipation of Applicant’s “editor”; Farros ‘810 relies upon the user to make these changes selected by the customer.

Paper No. 11 is therefore incomplete, and fails to comply with the requirement for completeness mandated by 37 CFR §1.104(b) and (c). Accordingly, the Examiner is respectfully requested to provide clarification by identifying the column and line number of Farros ‘810 that teaches Applicant’s “editor” and the storing of an “editing program”. Applicant requests an opportunity to respond to the Examiner’s clarification, prior to completion of the examination.

**Third**, the Examiner asserts that Applicant’s “claim 1 fails to recite a *printing agency*.” The Examiner is invited to focus upon the express language of claim 45, and to contemplate the possibility that claim 1 defines a “customer” may be a different constituent component of claim 45 from “the home page that can be accessed by a customer over the Worldwide Web” and may be different from the “editor” that is defined as “being distinguishable from said customer, none of which are taught by the Farros ‘810 reference.” Even ignoring *arguendo* these deficiencies in Farros ‘810, the Examiner has ignored the fact that Farros ‘810 does not teach Applicant’s “homepage that can be accessed by a customer” with Applicant’s “editor” and “output device” in combination. This is essential to maintenance of an anticipation rejection under 35 U.S.C. §102(b).

**Fourth**, on page 8 of the Examiner’s Comments, the Examiner confuses Applicant’s

“output device” with Applicant’s “editor” and asserts that Farros ‘810 “discloses the remotely-located storage and printing facility” which, when coupled with the Examiner’s “broad definition of *edit*”, allows the Examiner to maintain the anticipation rejection of claims 45, 46 and 54. The Examiner’s understanding of anticipation is flawed because Farros ‘810 expressly teaches that:

“the user is presented with a change screen which allows the individual aspects seen at 716-726 of the selected product may be changed. Once each of the individual aspects seen at 716-726 has been selected, or left in the default value, then the generation of the print order and the transmission of the print order as initially seen at 116 and Fig. 1 may be performed.” Farros ‘810, col. 8, lines 48-54.

As illustrated by this excerpt, Farros ‘810 teaches editing by the user, and by the user alone, as a separate element and aspect from the print order and subsequent production. In essence, the Examiner has failed to provide the clarity and completeness required under 37 CFR §1.104(b) and (c). The rejection is therefore premature and incomplete. The Examiner is therefore requested to provide clarification, and expressly identify the column and line number where Farros ‘810 teaches a broad definition of “edit” that includes the production step provided by Applicant’s “output device.” Absent this clarification, withdrawal of this rejection is requested.

**Fifth**, the Examiner should recognize that Farros ‘810, like the Chabrow publication, is directed to that portion of the industry known as “novelty printing”, which relies upon eye impact of stylization, colors, shifts in fonts and irregular and different layouts as well as novelty inks and materials. Both references depend upon users to wend their way through

a maze of templates, menus and instructions to produce a stylized, unique product suitable for the users unarticulated requirements. By way of example, previous fads in the novelty printing industry catered to consumers' desire to alter and misspell the famous "THINK" slogan of IBM Corporation, while current fads in the novelty printing industry catered to users' desires to misspell and otherwise alter the printing of the slogan "LISTEN" in various imaginative ways. Does the Examiner seriously expect that the novelty printing industry would alter the users personal preferences for a misspelling by engaging in editing of the user's text? The hallmark of the novelty printing industry is that the design of the product is left solely and exclusively to the customer. The Examiner's rejection depends upon an impractical modification of that industry to incorporate Applicant's editing, wholly without evidence of record. Consequently, the Examiner's application of §102(b) is not only improper, it is unsupported by the art of record. Its withdrawal is mandatory.

## **Claim 2**

The Examiner asserted in Paper No. 11, that Ferros '810 taught:

"an apparatus wherein said customer's first draft and said finalized version of said customer's print job comprises text, images and pictures (col. 3, lines 66-67; col. 4, lines 1-10; and col. 8, lines 58-60)."

What the Examiner ignores is that Applicant's claim 46 defines a "first draft" that is provided by the customer and a "finalized version of said customer's print job" that is created by Applicant's "editor", while Farros '810 discloses a single, finalized draft that is



both prepared, modified and verified by the customer alone. In view of the incompleteness of this rejection, the Examiner is respectfully requested to provide clarification under 37 CFR §1.104, identifying by column and line number, where Farros '810 teaches "an editor ... creating a finalized version of said customer's print job." In view of the utter failure of Farros '810 to recognize the need for Applicant's editor in combination with Applicant's homepage, memories and output device, there is no anticipation. Withdrawal of this rejection is required.

**Second**, Applicant's claim 46 defines the print job as comprising "text, images and pictures." Farros '810 however, provides clip art and templates; Farros '810 contemplates no contribution of "images and pictures" by the user, but relies upon the user to select via templates and menus. Moreover, Farros '810 relies upon the user alone to make any editing or modification of the images and pictures, and provides no teaching of an editor generating a finalized version of a print job containing images and pictures. In short, Farros '810 fails to anticipate claim 46, and claim 46 is therefore allowable over Farros '810.

#### **Claim 10**

The Examiner wrote that in Applicant's claim 10,

"the limitation "wherein said output device prints 180 sheets per minute" is functional claim language and carries little weight because it does not provide any physical limitation. Moreover, Farros teach an output device that is reasonably capable of printing 180 sheets per minute (col. 2, lines 27-32)."

The Examiner ignores the absence of the foregoing features of Applicant's memories, editor

and output device in Farros '810. Whether or not Farros could be reasonably read as teaching a particular printing speed, is irrelevant to these issues. Moreover, Farros '810 contemplates production of neither a manuscript nor document, but instead focuses upon discrete printing products. Moreover, Applicant has defined the "process of editing" in the originally filed specification, beginning on page 13, line 5. The Examiner cannot distort Applicant's definition of "editing". Furthermore, the Examiner cannot misread Applicant's definition of editing by substituting Applicant's "output device" when that output device is itself a separate and distinct constituent component of rejected claims 45, 46 and 54. The Examiner's misreading of these claims does not prove anticipation, and withdrawal of this rejection is required.

Regarding claims 45 and 54, in Farros '810, the kiosk or the personal system embodiments have graphic storage 204, a form storage 205 and a program module 206 that include files 105-109 at the terminal. Applicant submits that Farros '810 does not teach or suggest having a customer access a home page over the world wide web. Instead, in Farros '810, all the programs and storage needed to electronically create the document for printing are stored at the user's or customer's terminal instead of at a home page that is accessed only through the Internet. This deficiency in Farros '810 may not be ignored in making a determination of novelty under 35 U.S.C. §102(b).

**Rejection Of Claims 3-8, 11-13, 16-18 & 25-27 Under 35 U.S.C. §103(a)**

Claims 3-8, 11-13, 16-18 & 25-27 were rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of Ferros *et al.* '810 modified according to what the Examiner identified as "Official Notice." Applicant respectfully traverses this rejection for the following reasons, and discusses this rejection in terms of pending claims 47 through 52, 55 through 57, 60 through 62 and 69 through 71.

First, in support of this rejection, the Examiner asserted without authority or citation of any art, that he took:

"Official Notice that editing a customer's print job at a print agency connected to the customer via the internet is old and well known in the art."

Applicant disagrees. In essence, the Examiner has improperly applied an impermissible point-of-novelty criterion to the determination of obviousness under 35 U.S.C. §103, and then begged the question of whether the Examiner's point-of-novelty, namely "editing a customer's print job at a print agency" is obvious by taking "Official Notice that editing a customer's print job at a print agency connected to the customer via the Internet *is old and well known in the art.*" This is an impermissible application of 35 U.S.C. §103(a) which requires (1) an identification of "the differences between the subject matter sought to be patented and the prior art" and (2) a determination of whether "the subject matter *as a whole* would have been obvious at the time the invention was made." Paper No. 11 is therefore incomplete. In accordance with 37 CFR §1.104(b) and (c), the Examiner is respectfully requested to provide clarification and to explain:

- each of the “differences between the subject matter sought to be patented and the prior art”, as that subject matter is defined by independent claim 11.
- which combination of specific teachings in the prior art render the “subject matter” of claim 11 when taken “as a whole” obvious?
- additionally, the Examiner’s reliance upon “Official Notice” is improper and unfairly denies the Applicant the ability to examine the body of knowledge upon which that Official Notice is based and to distinguish the pending claims over that body of knowledge because the Examiner is relying upon his personal knowledge. In accordance with 37 CFR §1.104(d)(2), the Examiner is respectfully requested to provide the Examiner’s affidavit and in that affidavit describe the data as specifically as possible, and to support that data with the Examiner’s affidavit, in order to accord the Applicant an opportunity to contradict or explain the patentability of these rejected claims over the data and reference relied upon by the Examiner in his “Official Notice.”

Applicant submits that the *combination* of having a print agency electronically connected to a customer’s computer terminal via the internet, the print agency being able to print at a remote location, and the fact that editing takes place at the internet print agency is not old and well known in the art and it is not taught nor suggested by the prior art. Applicant submits that the notion that a traditional print shop may have editing services may not be relied upon in order to not infer that it is obvious under the “subject matter as a whole” criterion of 35 U.S.C. §103 to establish that the process defined by Applicant’s claim 11 is rendered obvious by Farros ‘810. No matter how modified according to the Examiner’s “Official Notice” of editing, Farros ‘810 is devoid of either teaching or suggestion for responding to Applicant’s print request containing attributes of a printing job by issuing “a cost estimate” and then “receiving a first draft of a customer’s printing job”. Instead, Farros ‘810 simply obtains and allows the customer to change or modify the attributes of the

printing job, and then allows the user to verify those attributes; only then does Farros '810 discuss pricing and nowhere precedes the reception of the printing job with a cost estimate. Consequently, Farros '810 is difficult and cumbersome for a user and requires that the printing job be completed before the user is given any inkling or notion of the cost. This requires to user to cancel the printing job and to re-start the printing job by selecting different menus, templates and modifications before the user is able to obtain the cost of the printing job. In contradistinction, claim 55 defines a process in which the attributes are first obtained, a cost estimate is readily issued and then the printing job itself is conveyed by the user to the agency and, unlike Farros '810, the user receives the benefit of editing by the agency, a feature wholly lacking and neither appreciated nor suggested by Farros '810. In view of these deficiencies in the Examiner's proposed combination of Farros '810, and the advantageous results flowing therefrom, claim 55 is patentably distinguishable and allowable over the prior art. Such action is respectfully requested.

**Second**, regarding claim 55, Applicant submits that Farros '810 does not disclose a printing agency and Farros '810 does not disclose any Internet connection to a print agency via the Internet. In Farros '810, all of the software needed to produce the document to be printed, the print order and the payment and quote are all done at either the customer's personal computer or a kiosk. The only exception to this is FIG. 4 of Farros '810, where the customer connects to software for producing the document and placing the print order via the internet *in an office environment*. This requires that customer to incur the expense of

obtaining and maintaining that software before undertaking a printing task, an expense that a customer or user is able to avoid in the practice of Applicant's claim 55. Applicant submits that reference numeral 401 in Farros '810 is not a print agency but is merely a storage that can be accessed by others in the same office. Reference numeral 401 in FIG. 4 of Farros '810 is not an internet site with a web page or a home page as claimed by Applicant. The purpose of reference numeral 401 in FIG. 4 of Farros '810 is to avoid requiring each and every user in an office environment from having to store the software to produce the document and the storage of the document itself to be printed at a user's personal computer. FIG. 4 of Farros '810 enables people in an office environment to access the software, not enabling the entire world wide web to access the software. Thus, it is submitted that FIG. 4 of Farros '810 does not have a home page and does not provide access to all internet users in the world wide web access to the software needed to create a document, to get a price quote or to submit a job order to a remote printer. In view of these distinctions and the noted benefits flowing therefrom, claim 55 is patentably distinguishable and allowable over the Examiner's proposed combination.

**Third**, the Examiner's proposed combination fails to make a *prima facie* showing of the obviousness of claim 55. In this Official Notice, the Examiner maintains that the step of receiving an online estimate is old and well known in the art. Applicant submits that receiving an on-line estimate in the context of Applicant's claim 55 is wholly absent from the Examiner's proposed combination of Farros '810 and Official Notice. Applicant states

in claim 55 a customer at a computer connected to a print agency that provides editing and cost estimates for a print job that is then sent to a third, remote location for printing. Applicant submits that the cost estimate in combination with the editing at the print agency is neither taught nor suggested by the prior art. These distinctions may not be ignored in making a determination of obviousness.

**Fourth**, claim 55 defines an editor at the print agency edits the customer's draft. The Examiner states that column 2, lines 25-30 and column 10, lines 62-67 of Farros '810 teach this limitation. Applicant notes that Farros '810 does teach having the customer, as distinguished from Applicant's "print agency", at the customer's terminal to modify the document. Applicant submits however, that there is no editing in Farros '810 that is carried out at any print agency or by any other entity other than the user, or customer. When making a determination of obviousness *vel non*, the Examiner may not either arbitrarily gloss over the existence of Applicant's *customer* and *print agency* and their respective aspects defined by claim 55, nor mix those distinct aspects. In view of the complete failure of Farros '810 to either recognize the need for Applicant's allocation of the several features of a print manufacturing process to more parties than solely the user, and to address that need, claim 55 is patentably distinguishable and allowable over the prior art. The fact that both the Examiner and Farros '810 have failed to appreciate this allocation of labor, regardless of who performs which specific task, is evidence of the impropriety of this rejection as well as the non-obviousness of Applicant's process. Its withdrawal and allowance of claim 55 is

required.

**Fifth,** Applicant submits that the editor in Applicant's claims needs to both be knowledgeable of editing skills that were in existence before computers and the internet and must also be knowledgeable of computer software, of digital imaging, of printing, and of the internet and much more, a combination of skills that did not exist in the past, making this fifth limitation neither taught nor suggested by the prior art. Furthermore, the editor, unlike the customer, specializes in electronic file and image editing, a feature that is not old and well known in the prior art. The customer does not have these skills because the customer does not specialize in these areas. Therefore, the notion of having an editor edit a document that contains text and images is not taught nor fairly suggested by the prior art.

**Claims 58 & 59**

Regarding claims 58 and 59, Applicant submits that the editing at the print agency corrects misspellings, corrects typographical errors and corrects unreadable characters due to different computer software or different font environment and formats page margins, line spacing, font size, page numbering, line numbering and paragraph numbering. Such process steps in the antithesis of the Examiner's proposed combination, which relies solely upon the user to enter, modify and verify all text. Applicant submits that the failure of the Examiner's proposed combination to address the limitations in these claims is further evidence that an editor at an internet print agency is not old and well known in the art.



**Claim 60**

Claim 60 defines the editing comprises enlarging and reducing pictures. The Examiner again takes Official Notice on the top of Page 9 of Paper No. 6. Applicant submits that it is the *editing done in an internet electronic environment* that is not old and well known in the art. Receiving files over the internet and professionally processing these files for printing at a remote location is not old and well known. Therefore, Applicant submits that this feature is not taught nor suggested by the applied prior art.

**Claim 61**

Claim 61 states that the editing process where a document to be later printed is edited by the print agency, the editing is reviewed by the customer, and a second editing is again conducted at the print agency. Once again, the Examiner takes Official Notice for these steps and then states that it would have been obvious to modify Farros '810 to include the 6 limitations of claim 61. Applicant disagrees. Applicant first submits that Farros '810 does not pertain to an internet print service as discussed above. Assuming *arguendo* that Farros '810 did pertain to an internet printing service, Applicant submits that there is no basis in the art of record with which to modify Farros '810 to include these features of claim 61, because no component except the user can be argued to provide any editing in the Examiner's proposed combination. Absent this, and the concomitant advantages, there is no *prima facie* showing of obviousness. Applicant submits that the editor advantageously endows Applicant's process to both be knowledgeable of editing skills that were in existence before

computers and the internet and also be knowledgeable of computer software, of digital imaging, of printing, and of the internet and much more, a combination of skills that did not exist in the past, a combination of skills that are neither taught nor suggested by the prior art.

**Rejection Of Claims 20-24 Under 35 U.S.C. §103(a)**

Claims 20-24 (which Applicant discusses here as newly presented claims 64 through 68) were again rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of the article authored by E. Chabrow entitled *iPrint Self-Service Printing* published in the 13<sup>th</sup> of December 1999 edition of *Information Week*, modified according to Ferros *et al.* '810. Applicant respectfully traverses this rejection for the following reasons.

In support of this rejection, the Examiner argued that,

“Chabrow teaches a system for printing a document having text, images and pictures, comprising:

a user computer terminal connected to the Internet (page 1, paragraph 1)<sup>11</sup>

a printing agency accessible via the Internet by said user computer (page 1, paragraph 1). Chabrow does not teach an editor connected to said printing agency for editing a manuscript submitted by said user to said printing agency to produce said document having text, images and pictures job, said editor not being said customer. However, Farros teach a system for remotely ordering a printed product wherein the attributes of a saved print job are altered electronically and wherein the print

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<sup>11</sup> The Examiner wrote in footnote 3, that “Chabrow inherently teaches a user computer terminal connected to the Internet. Chabrow discloses having a user access a Website to design a printed product (page 1, paragraphs 1-3). Because accessing a Website requires the implementation of a computer, Chabrow inherently teaches a user computer terminal connected to the Internet.”

job may be printed at a remote location<sup>12</sup> (col. 8, lines 42-67; and Fig. 4). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teachings of Farros because an editor connected to said printing agency for editing a manuscript submitted by said user to said printing agency to produce said document having text, images and pictures would provide a means for correcting customer errors prior to transmitting and printing the customer's document.

Chabrow further teaches a first plurality of output devices located at a second plurality of locations distant from said printing agency, each of said first plurality of output devices connected to said printing agency via computer network printing (page 1, paragraphs 3 and 8)."

Eric Chabrow pertains to an article in "Information Week" that discusses a website "www.iprint.com" that enables printing of images and/or text on a variety of media. www.iprint.com doesn't do its own printing but transmits orders over the internet to commercial printers to be fulfilled. Like Farros '810, there is no editor at the place where the customer submits the document to provide professional services for the customer.

The Examiner's reading of Chabrow is technically inaccurate. Chabrow states that it provides a process for "reducing prepress costs", and discloses nothing more. This is the same "prepress process" disclosed in Fig. 7 of Farros '810, preceding the manufacturing of the product subsequent to step 728 of Farros '810. It is noteworthy that all of the "prepress process" is performed by the user, or customer, and that there is no editing performed either

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<sup>12</sup> The Examiner wrote in footnote 4 that, "as noted under footnote 2, Farros discloses an editor that is distinguishable from the customer."

by Chabrow or by Farros '810. In short, the Examiner's proposed combination is nothing more than disclosed by Farros '810, with the software allowing "customers [to] design, proofread and order personalized business cards, stationery, checks, rubber stamps, sticky notes, labels, and novelty gifts such as golf balls and coffee mugs [and to ... also] import graphics as well as adjust layouts, fonts, and ink colors to customize print products<sup>13</sup>" via either a kiosk terminal or a personal computer terminal, in an entirely user controlled transaction extending from the user initiated prepress selection of the (1) "entry of textural information (personal information)" and verification in step 1002,<sup>14</sup> of the (2) selection of "the quantities of each orderable product" in step 1004,<sup>15</sup> and the selection of the (3) product type,<sup>16</sup> (4) category of product,<sup>17</sup> (5) layout of the chosen category,<sup>18</sup> and designation of the attributes of the category in the plurality of options<sup>19</sup> presented to the user in step 1006,<sup>20</sup> to completion and submission of the order by the user in step 1012.<sup>21</sup> Neither taught nor suggested by Farros '810 is any division of labor made by Applicant's claim 64; these tasks

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<sup>13</sup> Chabrow, 4<sup>th</sup> paragraph.

<sup>14</sup> Farros '810, column 10, lines 51, 52.

<sup>15</sup> Farros '810, column 10, lines 54, 55.

<sup>16</sup> Farros '810, column 10, line 55.

<sup>17</sup> Farros '810, column 9, lines 23, 24.

<sup>18</sup> Farros '810, column 9, line 25.

<sup>19</sup> Farros '810, steps 1007-1011, column 10, line 56.

<sup>20</sup> Farros '810, column 10, lines 60-67.

are preformed solely and entirely by the user in response to a plurality of templates and menus. Neither Chabrow nor Farros '810 disclose or suggest "an editor editing a manuscript submitted by a user" in combination with "returning said document to the user" and "receiving a revision of said document from the user, in combination with Applicant's "server accessible via the Internet."

The Examiner's singular inability to contemplate the distinction between the software taught by the primary and secondary references, and the user, or customer, who alone controls and selects, modifies and verifies a product using that software without the assistance of either Applicant's "printing agency" or "editor" as set forth in rejected claim 64, is telling evidence that, on the instant record demonstrates, the impropriety of the rejection of claim 20; accordingly, allowance of claim 64 is indicated. Similarly, the common inability of both Chadbrow and Farros '810, as well as the Examiner, to either appreciate a need for Applicant's "user computer", "printing agency" and "editor" as set forth in claim 64, or the singular inability of both Chadbrow, Farros '810 and the Examiner to appreciate the beneficial contribution enjoyed by a user at Applicant's "user computer" with Applicant's division of labor between Applicant's "user computer", "printing agency" and "editor", and Applicant's combination with an allocation of labor between the user and a printing agency is further and additional convincing evidence on the record of the non-obviousness of claim 64. Moreover, the Examiner's inability to understand that a claim which distinctly defines separate constituent elements, is telling of the impropriety of the

rejection. The Examiner can not read distinct components as comprising one in the same element. In view of this impropriety, the foregoing omissions in the Examiner's proposed combination, the advantages intrinsic in any allocation of labor between different constituent components of a claim, as well as the absence of a *prima facie* showing of obviousness, withdrawal of this rejection is required.

**Rejection Of Claims 9, 14, 15 & 19 Under 35 U.S.C. §103(a)**

Claims 9, 14, 15 and 19 (which Applicant discusses here as claims 53, 58, 59 and 63) were rejected under 35 U.S.C. §103(a) as rendered obvious over the Examiner's proposed combination of Farros '810 modified according to Chabrow. Applicant respectfully traverses this rejection for the foregoing reasons, and for the following additional reasons.

**First,** In support of the rejection, the Examiner asserts that while Farros '810 fails to teach "an internet printing apparatus wherein editing comprises correcting misspellings, correcting typographic errors, and correcting unreadable character", Chabrow "teaches a system for ordering print products via an Internet Website wherein users proofread print product orders before orders are submitted (pg. 1, para. 3)." The Examiner's proposed combination is impractical, contrary to the express teachings of the primary and secondary references, and is fictitious; moreover, there is no basis in either reference for making the Examiner's assertion that:

"Farros suggest [*sic*, suggests] incorporating an editing step comprising correcting misspellings, correcting typographical errors, and correcting unreadable characters due to different

software computer programs and different font environment in that Farros disclose [*sic*, discloses] having a user perform a final verification of a print job order (col. 3, lines 10-14).” Examiner’s Comments, Paper No. 11, pg. 19.

In fact, Farros nowhere makes this teaching or suggestion. Moreover, the Examiner’s proposed combination dwells solely in the novelty printing industry in which the customer is given sole discretion over the use of misspellings, and misspellings are often prized by customers in this industry for their uniqueness and eye catching ability, as are novelty inks, different colors and irregular layouts. Does the Examiner really believe that Farros ‘810 intends to edit the deliberate misspelling sought by a customer, by eliminating those misspellings? Evidently, the Examiner is relying upon some personal knowledge and insight to support this assertion; accordingly, Applicant respectfully requests the Examiner’s affidavit pursuant to 37 CFR §1.104, in order to give Applicant an opportunity to respond and challenge the Examiner’s data upon which this assertion is based. Absent this, rejection of this withdrawal is required.

**Second**, in both the primary and secondary references, all creativity, all modifications, all changes and all verifications are performed solely by the user, alone, without intervention, modification or editing of the user’s creation. The Examiner’s proposed combination impermissibly requires both the primary and secondary references to be operated in a mode that would destroy their intended mode of operation which leaves all decisions, editing, modifications and verification to the user alone. This impermissible modification of the primary reference convincingly demonstrates the non-obviousness of the

rejected claims, and requires withdrawal of this rejection and allowance of claims 53, 58, 59 and 63 is indicated.

**Rejection Of Claims 28 & 29 Under 35 U.S.C. §103(a)**

Claims 28 and 29 (discussed here as claims 72 and 73) were rejected under 35 U.S.C. §103(a) as rendered obvious by the Examiner's proposed combination of Chabrow and the article published in PR Newswire entitled *New Internet Approved To Streamline Process For Editing Documents On The Web*, on the 8<sup>th</sup> of December 1999. Applicant respectfully traverses this decision for the following reasons.

**First**, the Examiner admits that Chabrow fails to teach an editor at a printing agency "having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency", but asserts that the PR Newswire article "teaches a system for collaboratively editing documents over the Internet." Paper No. 11, pgs. 21-22. The Examiner concludes however, that modification of Chabrow according to the teachings of the PR Newswire Paper finds motivation in the fact that the "printing agency would enable the customer to improve the quality of their documents." The Examiner's asserted motivation for modification of the primary reference is specious, unfounded by the evidence of record and would require the primary reference to be operated in a mode of operation contrary to its intended mode. Specifically, Chabrow lies in the novelty printing industry which endows users to alone have sole control over the creation, editing and verification of



the user's design, independently of any modification, change or editing by the printing agency. The Examiner's proposed modification of Chabrow would destroy this intended mode of operation, and concomitantly deny the user such discretionary enjoyment as printing with deliberate, noticeable and remarkable misspellings of famous words. Accordingly, the modification is impermissible and the rejection must be withdrawn, and claims 72 and 73 allowed.

**Rejection Of Claim 30 Under 35 U.S.C. §103(a)**

Claim 30, discussed here as claim 74, was separately rejected under 35 U.S.C. §103(a) as rendered obvious over a proposed combination of Chabrow, the PR Newswire article and what the Examiner asserts to be "Official Notice." Applicant respectfully traverses this rejection for the following reasons.

In support of the Examiner's proposed combination and modification of the primary reference, the Examiner stated that:

"The Examiner takes Official Notice that indicating these in a customer print order is old and well known in the art."

Claim 74 defines Applicant's "editor" as "being a different entity than said customer." Neither Chabrow, the PR Newswire nor the Examiner's Official Notice teach any editor other than the customer. In fact, these references are singular and consistent in the customer controlling the editing, modification and verification of the final product. Furthermore, as was earlier noted, shifting the editor from the user to a print agency would impermissibly

destroy the intended mode of operation of Chabrow. Consequently, the Examiner's proposed combination is improper, and this rejection must be withdrawn. Allowance of claim 74 is therefore required.

**Rejection Of Claims 31-37 Under 35 U.S.C. §103(a)**

Claims 31-37, discussed here as claims 75 through 81, were rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of Chabrow, the newly cited Goldberg U.S. Patent No. 6,196,146 and the Examiner's "Official Notice." Applicant respectfully traverses this rejection for the following reasons.

**First**, the Examiner admits that Chabrow neglects to teach a cost request, generation of a cost estimate, and transmission of identification data and second data to the user, but asserts that Goldberg '146 somehow remedies these deficiencies by teaching "a method of providing a customized product to a user over the Internet, including the steps of receiving a request for a quote and transmitting a cost estimate to the user in response to the request (Abstract; and col. 5, lines 25-27). As was earlier noted, Chabrow demands that the user provide the sole and exclusive control of the creation, modification, editing and verification of each printing job. This feature is not negated by Goldberg '146, which is expressly teaches in Figs. 2 and 4, and in column 4, beginning with line 6, editing performed solely by the user. In contradistinction, claim 75 defines a "first editing being performed by a editor and not by the user." The Examiner has not addressed this distinction.

The Examiner is reminded that the express language of 35 U.S.C. §103 requires that

the Examiner identify “the differences between the subject matter sought to be patented and the prior art.” The foregoing difference, among several others defined by the pending claims, have not been identified in this rejection. Accordingly, this rejection is incomplete and fails to meet the requirements imposed by 37 CFR §1.104(b) and (c). Clarification of this rejection, completion of the office action in conformance with Rule 1.104, and the allowance of an opportunity to the Applicant to respond to the complete rejection, is requested. Absent this, withdrawal of the rejection and allowance of claims 75 through 81 is respectfully urged.

**Rejection Of Claims 38 & 39 Under 35 U.S.C. §103**

Claims 38 and 39 were rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner’s proposed combination of Goldberg ‘146 modified according to Chabrow and the PR Newswire article. Applicant respectfully traverses these rejections for the following reasons. The Examiner admits that Goldberg ‘146 includes several remarkable deficiencies, and does not meet the definition provided by independent claim 38.

The Examiner’s motivation for this proposed combination is flawed and factually incorrect. The Examiner relies upon the PR Newswire article to modify Goldberg ‘146 to include “an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal ...” and asserts that the motivation for this modification of Goldberg ‘146 “would enable the

customer to improve the quality of their documents.” Paper No. 11, pg. 28. In fact, the Examiner’s proposed combination would impermissibly destroy the intended mode of operation of Goldberg ‘146 which teaches editing, in step 68, as being done exclusively and solely by the user. See col. 4, line 6+. Moreover, the Examiner has misrepresented the teachings of the secondary reference; the PR Newswire discloses “web editing software”, which “allows people to easily and collaboratively edit their web documents” in order to avoid the problem known as the “lost update problem.” Goldberg ‘146 however, provides no editing by anyone other than the user; in step 54, the embroidery service provides a facsimile in lieu of a prototype, but defers any editing or modification of the facsimile to the user in step 68. The Examiner’s proposed modification of Goldberg ‘146 would impermissibly rob the user of this exclusivity, and ostensibly open the editing of the garment to the public. How this modification “would enable the customer to improve the quality of their documents” is unexplained in the Examiner’s action, because it is a garment, and not a document, that is created by Goldberg ‘146. Furthermore, this rejection is deficient because the Examiner neglects to identify precisely where this third party editing of the garment would occur in Goldberg ‘146; subsequent to the simulation modeling in step 54 or subsequent to the user’s editing in step 68 would interfere with the user’s creativity. Any subsequent third party editing would destroy that final creation. In short, this rejection is incomplete under the criteria of 37 CFR §1.104(b) and (c). Written clarification and allowance of an opportunity for Applicant to respond to the completed rejection is respectfully requested. Alternatively, withdrawal of this rejection and allowance of the

rejected claims is solicited.

The Examiner has taken Official Notice of the use of a password for accessing a customer's estimate and Official Notice of storing customer order profile information on a remote database. In accordance with 37 CFR §1.104 (a), (b) and (c), the Examiner's affidavit detailing the data relied upon by the Examiner for this Official Notice is respectfully requested.

**Rejection Of Claims 39-42 And 44 Under 35 U.S.C. §103(a)**

Claims 39 through 42 and 44 were rejected under 35 U.S.C. §103(a) as rendered obvious, and unpatentable, over the Examiner's proposed combination of Goldberg '146, Chabrow, the PR Newswire article and the Examiner's Official Notice. Applicant respectfully traverses these rejections for the following reasons.

**First**, these claims all ultimately depend upon independent claim 38. The Examiner's proposed combination does not remedy the deficiencies noted in the foregoing paragraphs of this amendment, in the rejection of claim 38. Accordingly, this rejection is incomplete and improper. Its withdrawal is required.

**Second**, claim 39 defines, *inter alia*, correction of spelling. Goldberg makes no pretense of interfering with a customer's spelling; modification of Goldberg to provide correction of spelling would impermissibly destroy the intended mode of operation of Goldberg. Accordingly, this rejection of claim 39 is improper and may not stand.

Dependent claim 40 contemplates enabling the user to select "the output device

geographically nearest to the user”; this feature is neither taught nor suggested by any of the applied references. It is difficult to understand how these references could be relied upon to render this feature of claim 40 obvious, when none of these references use the terms “geographically nearest to the user”? In view of the implausibility of the Examiner’s rationale, withdrawal of this rejection is required. The Examiner has relied upon Official Notice as teaching geographic location and the selection of service based upon the geographic location. The Examiner is requested in accordance with 37 CFR §1.104 to provide his affidavit specifying the data upon which the Examiner has relied for this Official Notice, and to accord Applicant an opportunity to contradict and challenge the Examiner’s data.

Claim 41 contemplates transmission of “edited print data through the Internet to the user after said editing unit performs the editing of the print data” and “the user receiving the edited data through the Internet and revising the edited print data and sending the revised print data to the server. This combination is not suggested by any of the Examiner’s references, and may not therefore be attributed to the Examiner’s proposed combination. The fact that the PR Newswire mentions, but does not teach, a system for collaboratively editing what is known as “web documents” is irrelevant to the issue of the obviousness of claim 41. The PR Newswire Paper acknowledges that its distributed authority and versioning standard will allow “users to conveniently manage Internet files and directories, including the ability to move and copy files, similar to the way word-processing files and directories are managed on a regular computer.” Pg. 2. What is missing from this reference

is teaching or suggestion of editing “word-processing files and directories” by an editing unit that is defined as “being distinguishable from the user” (pg. 38, line 16). In fact, the web editing contemplated by the PR Paper allows collaborative editing of web documents, but neither teaches nor suggests modification of a service such as that provided by Goldberg ‘146, the primary reference, which enables the user to obtain the editor’s services. The Examiner should again consider that claim 38 separately and distinctly defines Applicant’s “editing unit” and “user”, although the user is not constituent component of claim 38. The Examiner’s pretense that the editing unit and the user are one in the same entity, is contrary to U.S. practice. Accordingly, there is no basis for making the Examiner’s proposed combination, the combination would destroy the intended mode of operation of Goldberg, and the combination fails to make a *prima facie* showing of obviousness of claim 41.

Although Goldberg does generate a cost estimate, that cost estimate does not remedy the foregoing deficiencies noted in the Examiner’s proposed combination. Accordingly, claim 42 is patentably distinguishable and allowable over the prior art.

In support of the rejection of claim 44, the Examiner argues that his Official Notice of attributes of the job such as the number of pages, the number of copies, and the type of binding, are old and well known. None of the references suggest these attributes. Moreover, the Examiner’s Official Notice fails to remedy the deficiencies noted in the rejection of parent claim 38. Accordingly, claim 44 is deemed to be patentably distinguishable and allowable over the prior art.


Allowance Of Claim 43

The Examiner has made no rejection of dependent claim 43. Applicant understands therefore, that claim 43 is allowable, if placed in independent form. Applicant requests the Examiner's forbearance until the Examiner has had an opportunity to reconsider the foregoing rejections, in view of these amendments and explanations.

No fee is incurred by this Substitute Amendment.

In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

  
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